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17 FEB 2006

In re Application of	:	
Harvey et al.	:	
Application No.: 10/509,706	:	DECISION
PCT No.: PCT/CA03/00717	:	
Int. Filing Date: 16 May 2003	:	ON
Priority Date: 16 May 2002	:	
Attorney Docket No.: 47220.7	:	PETITION
For: Wind Turbine With Hydrostatic Transmission	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 02 December 2005.

### **BACKGROUND**

This international application was filed on 16 May 2003, claimed an earlier priority date of 16 May 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 27 November 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 16 November 2004. Applicants filed *inter alia* the basic national fee on 30 September 2004.

On 03 May 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee is being charged to counsel's Deposit Account No. 02-2057, as authorized by the Transmittal Letter filed on 30 September 2004.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor David McConnell be excused because he allegedly "refuses to sign the application despite being presented with the application papers for his execution." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands

exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

In the "Affidavit Under 37 CFR 1.47," Alexander S. Harvey states that "A copy of the application papers including a declaration and the patent specification were forwarded to both inventors and have been subsequently signed by Alexander S. Harvey," and that "Application papers were sent to the home address of Mr. David McConnell" on June 2, 2005. It is unclear whether these statements, appearing in paragraphs 7 and 8 of the "Affidavit...", refer to the same correspondence, or whether correspondence was sent to Mr. McConnell on two separate occasions. Moreover, although Mr. Harvey states that the 02 June 2005 correspondence was "sent by courier to Mr. David McConnell," no evidence is presented on the point of whether the courier actually delivered the correspondence. Also, it appears that the correspondence in question may have been sent by Mr. Yoo, rather than Mr. Harvey; if this is the case, applicants are reminded that all statements should be made on the basis of first-hand knowledge rather than hearsay. In any renewed petition, counsel should present any available evidence pertaining to the issue of whether the courier actually delivered the parcel in question.

Regarding requirement (3), the petition includes a statement the last known address of Mr. McConnell (appearing in paragraph 11 of the "Affidavit Under 37 CFR 1.47" signed by Alexander S. Harvey). Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by a declaration document signed by joint inventor Alexander S. Harvey on behalf of himself and non-signing joint inventor David McConnell. This declaration satisfies requirement (4).

### **DECISION**

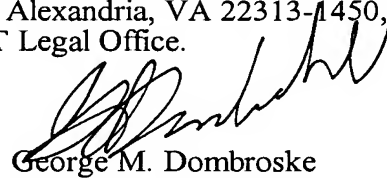
The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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